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OFFICE OF PETITIONS

CLARK & ELBING LLP / EISAI
101 FEDERAL STREET
SUITE 1500
BOSTON MA 02110

In re Patent No. 7,470,720	:	
Littlefield et al.	:	DECISION ON REQUEST
Issue Date: December 30, 2008	:	FOR RECONSIDERATION OF
Application No. 10/687,526	:	PATENT TERM ADJUSTMENT
Filed: October 16, 2003	:	and
Attorney Docket No. 04520/029002	:	NOTICE OF INTENT TO ISSUE
	:	CERTIFICATE OF CORRECTION

This is a decision on the "APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705," filed on February 27, 2009. Patentee requests that the Patent Term Adjustment for the above-identified patent be increased by thirty-seven (37) days from 456 days to 493 days.

The request for reconsideration of the patent term adjustment indicated in the patent is **GRANTED**.

The patent term adjustment indicated in the patent is to be corrected by issuance of a certificate of correction showing a revised Patent Term Adjustment of four hundred ninety-three (493) days.

On December 30, 2008, the above-identified application matured into U.S. Patent No. 7,470,720. The instant request for reconsideration filed on February 27, 2009 was timely filed within 2 months of the date the patent issued. See § 1.705(d). The Patent issued with a revised Patent Term Adjustment of 456 days.

Patentee contends that the reduction in patent term adjustment of 37 days for the filing of a miscellaneous incoming letter after the mailing of the notice of allowance, is incorrect and should be removed. Specifically, patentee asserts that the letter filed on November 24, 2008 was a transmittal letter and an authorization to charge the issue and publication fees and was not a failure to engage in reasonable efforts to conclude processing or examination.

The OG Notice¹ states that:

Accordingly, the Office is publishing this notice to provide guidance in interpreting the provisions of 37 CFR 1.704(c)(10) to clarify that submission of certain papers after a "Notice of Allowance," which do not cause substantial interference and delay in the patent issue process, are not considered a "failure to engage in reasonable efforts" to conclude processing or examination of an application. The following are examples of such papers: (1) Issue Fee Transmittal (PTOL-85B), (2) Power of Attorney, (3) Power to Inspect, (4) Change of Address, (5) Change of Status (small/not small entity status), (6) a response to the examiner's reasons for allowance, and (7) letters related to government interests (e.g., those between NASA and the Office). Therefore, the submission of these papers after a Notice of Allowance will not be considered a "failure to engage in reasonable efforts" to conclude processing or examination of an application and would not result in reduction of a patent term adjustment pursuant to 37 CFR 1.704(c)(10). Papers that **will be** considered a failure to engage in reasonable efforts to conclude processing or examination of an application include: (1) a request for a refund; (2) a status letter; (3) amendments under 37 CFR 1.312; (4) late priority claims; (5) a certified copy of a priority document; (6) drawings; (7) letters related to biologic deposits; and (8) oaths or declarations. 37 CFR 1.704(c)(10).

(emphasis added)

¹ See Revision of Patent Term Extension and Patent Term Adjustment Provisions, 1282 O.G. 100, 69 Fed. Reg. 21704, April 22, 2004.

A review of the official file reveals that this letter was a "Reply to Notice of Allowance." The letter references the accompanying PTOL-85(b) Fee(s) Transmittal form and authorizes the charging of the issue fee, publication fee, and the patent copy fee for ten patent copies.

Accordingly, the subject letter is not considered a "failure to engage in reasonable efforts" to conclude processing or examination of an application. Patentees should not have been assessed the 37 days of applicant delay for the filing of the "Reply To Notice of Allowance" filed on November 24, 2008.

In view thereof, the patent term adjustment indicated on the patent should be four hundred ninety-three (493) days (806 days of Office delay and 313 (350-37) days of applicant delay).

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

The application is being referred to the Certificate of Correction Branch for issuance of a certificate of correction to rectify this error. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by FOUR HUNDRED NINETY-THREE (493) days.

Telephone inquiries specific to this matter should be directed to Douglas I. Wood, Senior Petitions Attorney, at (571) 272-3231.



Anthony Knight
Supervisor
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE
CERTIFICATE OF CORRECTION

PATENT : 7,470,720 B2

DATED : December 30, 2008

INVENTOR(S) : Littlefield et al.

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On the cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by (456) days

Delete the phrase "by 456 days" and insert – by 493 days--